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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/859,995 05/21/97 HEMPLEMAN

EXAMINER

LM01/0329
DRESSLER ROCKEY MILNAMOW AND KATZ
TWO PURDENTIAL PLAZA
SUITE 4700
180 NORTH STETSON AVENUE
CHICAGO IL 60601

ATTORNEY	PAPER NUMBER
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DATE MAILED:

03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/859,995

Applicant(s)

Hempleman et al.

Examiner

Kindred

Group Art Unit

2776

☒ Responsive to communication(s) filed on 12-16-99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 30-79 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 30-67, 72-74, and 76-79 is/are rejected.

☒ Claim(s) 68-71 and 75 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This action is responsive to communications: Amendment B, filed on 12/16/99.
2. Claims 30-37 are pending. Claims 30, 33, 35 and 51 are independent claims.

Allowable Subject Matter

3. Claims 68-71 and 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest “in response to the entries of the updated list, downloads, from the source, via the link, and then presents at least some of the items on the list . . . maintains billing information for transmission to the source for billing . . .”, combined with “the entries on the play list from the displaced source via the communications link after determining the work is unavailable from local sources”

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-67, 72-74, and 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard U.S. Patent Number 5,918,213, filed 12/22/95, class 705/26, title "System and method for automated remote previewing and purchasing of music, video, software, and other multimedia products", in view of Goldman, U.S. Patent Number 5,809,246, filed 3/1997, class 709/217, title "Selection and retrieval of music from a digital database", and further in view of Mimick et al., 5,594,601, filed 05/1996, class 360/72.2, title "Method of programming audio tracks in a sequential medium."

With respect to independent claim 30, **Bernard et al.** discloses "a graphical display" ("fig. 5 teaches a graphical display"--sheet 5 of 45) "a data base for storage of a media inventory including at least audio items" ("elects to order the title sampled, VRU 104 . . . the order is maintained in interactive transaction database 112 . . ."--column 35, line 44) "a processor, coupled to the display and the data base with a plurality of instructions executable by the processor wherein some of the instructions present on one part of the display at least a part of a media inventory listing of at least the stored audio items, from which a user can select a plurality of items to be presented" ("automated order information can further include location information indicating to automated order picker 4303 . . . retrievers their ordered items from their designated locations updates the inventory to reflect the fact that . . . interactive transaction database . . ."--column 60, line 43). **Bernard et al.** does not disclose "wherein others of the instructions enable the user to select a named, prestored play list and display at least part of the selected list . . .

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additional instructions enabling the user to select at least one entry from the media inventory listing . . .”. **Mimick et al.** teaches “wherein others of the instructions enable the user to select a named, prestored play list and display at least part of the selected list . . . additional instructions enabling the user to select at least one entry from the media inventory listing . . .” (“a method for programming or editing, or both, the order of performance of digitally recorded information tracks, such as an audio recording, stored sequentially in an appropriate medium . . .”--abstract). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Mimick “wherein others of the instructions enable the user to select a named, prestored play list and display at least part of the selected list . . . additional instructions enabling the user to select at least one entry from the media inventory listing . . .” (“a method for programming or editing, or both, the order of performance of digitally recorded information tracks, such as an audio recording, stored sequentially in an appropriate medium . . .”--abstract) with the teachings of Bernard above, because using the steps of “wherein others of the instructions enable the user to select a named, prestored play list and display at least part of the selected list . . . additional instructions enabling the user to select at least one entry from the media inventory listing . . .” would have given those skilled in the art the ability to edit the sequential order of audio item to be processed according to a user’s preference. **Bernard et al.** does not disclose “insert the selected entry into the selected play list thereby creating a modified play list . . .”. **Goldman** discloses “insert the selected entry into the selected play list thereby creating a modified play list . . .” (“the order of songs can be programmed in advance and played

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without staff intervention . . .”--column 1, line 44). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Goldman “insert the selected entry into the selected play list thereby creating a modified play list . . .” (“the order of songs can be programmed in advance and played without staff intervention . . .”--column 1, line 44) with the teachings of Bernard above, because using the steps of “insert the selected entry into the selected play list thereby creating a modified play list . . .” would have given those skilled in the art the ability to store and play selected media data in a preferred order. **Bernard et al.** does not disclose “display at least part of the selected list simultaneously on another part of the display.” It would have been obvious at the time of the invention for one of ordinary skill in the art to have embodied steps similar to the claimed simultaneously step for the following reasons. First, to display a selection from a data base source simultaneously on two or more display will allow those skilled in the art the ability to view and select multiple selections at the same time thereby increasing the odd of getting the selection of choice. Second, displaying selection information and instructions simultaneously on separate monitor is well-known in the art and it not expected that patents and product reviews would disclose such fine detail showing such steps as simultaneously displaying selection information.

With respect to dependent claim 31, this claim is rejected on ground s corresponding to the arguments given above for rejected independent claim 30 and is similarly rejected.

With respect to dependent claim 32, **Bernard et al.** does not disclose “instructions for displaying a plurality of pre-stored play lists and enabling a user to select and execute from the

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data base one of the displayed play lists independently of the sources of the media entries in the select lists.”. **Goldman** discloses “instructions for displaying a plurality of pre-stored play lists and enabling a user to select and execute from the data base one of the displayed play lists independently of the sources of the media entries in the select lists” (“the choice of one or more music selections is then retrieved from the common digital database and transmitted over the communications network to the user . . .”--column 3, line 66). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Goldman “instructions for displaying a plurality of pre-stored play lists and enabling a user to select and execute from the data base one of the displayed play lists independently of the sources of the media entries in the select lists” (“the choice of one or more music selections is then retrieved from the common digital database and transmitted over the communications network to the user . . .”--column 3, line 66) because using the steps of “instructions for displaying a plurality of pre-stored play lists and enabling a user to select and execute from the data base one of the displayed play lists independently of the sources of the media entries in the select lists” would have given those skilled in the art the tools to manipulate audio selections in a database to the satisfaction of the user.

With respect to independent claims 33 and 35 and dependent claims 34 and 36-37, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 30 and dependent 31-32. In independent claims 33 and 35 and dependent

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claims 34 and 36-37, Applicant claims a method which contains steps corresponding to the system of rejected independent claim 30 and dependent claims 31-32.

With respect to independent claims 38, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 33 and is similarly rejected except for the following: **Bernard et al.** discloses “a communication link, coupled to the processor, at least intermitting, for receipt of as least some of the works specified by the updated list . . .” (“automated product purchasing system . . . means for downloading a portion of a desired one of said media products . . . indication of customer history and customer music preference . . .”--column 63, line 16). **Bernard et al.** does not disclose “a user station which includes a first programmable processor and an associated control program for storing at least one previously created play list . . .”. **Goldman** discloses “a user station which includes a first programmable processor and an associated control program for storing at least one previously created play list . . .” (“a processor system is provided for programming the digital radio broadcast station with a sequence of music selections . . .”--column 2, line 50). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Goldman “a user station which includes a first programmable processor and an associated control program for storing at least one previously created play list . . .” (“a processor system is provided for programming the digital radio broadcast station with a sequence of music selections . . .”--column 2, line 50) with the teachings of Bernard above, because using the steps of “a user station which includes a first programmable processor and an associated control

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program for storing at least one previously created play list . . .” would have given those skilled in the art the tools to program the sequential manipulation of a play list.

With respect to dependent claim 39, **Bernard et al.** discloses “responsive to request from the user station for transmitting requested items via the link, to be presented by the first processor and for receiving billing information” (“input from the customer, said input identifying a desired one or more of a plurality of media product the customer would like . . . products without making purchases . . .”--column 63, line 64).

With respect to dependent claims 40, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claim 30 and is similarly rejected.

With respect to dependent claim 41, **Bernard et al.** discloses “whereby items received from the inventory or a local invent at the user station can be written to a removable medium” (“means for obtaining and maintaining a user profile for the customer . . .”--column 61, line 64).

With respect to dependent claim 42, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claim 1 is similarly rejected.

With respect to dependent claim 43, **Bernard et al.** does not disclose “wherein the user station includes a media reader for incorporate locally read items into the list.” **Mimick et al.** discloses “wherein the user station includes a media reader for incorporate locally read items into the list” (“the apparatus further includes means for , coupled to the control processor, for reading the information tracks and converting the information tracks in a form different than as stored . . .”--column 2, line 41). It would have been obvious at the time of the invention for one of

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ordinary skill in the art to have combined the teachings of Mimick “wherein the user station includes a media reader for incorporate locally read items into the list” (“the apparatus further includes means for , coupled to the control processor, for reading the information tracks and converting the information tracks in a form different than as stored . . .”--column 2, line 41) with the teachings of Bernard above, because using the steps of “wherein the user station includes a media reader for incorporate locally read items into the list” would have given those skilled in the art the tools to read and combined a play list of audio items in a user workstation. This give users the advantage of being able to combined and store titles of selections in a workstation.

With respect to dependent claim 44, this claim is rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 38 and is similarly rejected.

With respect to independent claim 45 and dependent claims 46-50, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claims and 30 and 38 and dependent claims 31-32 and are similarly rejected.

With respect to claim 51, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected except for the following: **Bernard et al.** discloses “wherein the processor can provide billing information via the link to a billing processor” (“the user would access the automated product purchasing system via a network connection and browse the selections available within the automated product purchasing system . . .”--column 50, line 49).

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With respect to claims 52-62, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claims 30 and 38 and dependent claims 31-32, 34 and 35 and 36 are similarly rejected.

With respect to dependent claim 63, **Bernard et al.** discloses “writing items identified in a selected play list to removable medium for subsequent playback” (“once a selection is made, VRU 104 plays a script which . . . With a listing . . .”--column 16, line 47).

With respect to dependent claims 64-67, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 1 and dependent claims 31-32 and 34 and are similarly rejected.

As per claim 72, **Bernard et al.** discloses “when the control program presents at least some of the items of the list to local user, the items presented represent full versions” (“the automated product purchasing system is used for purchasing musical title . . .”--column 7, line 41).

As per claim 73, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 72 and are similarly rejected.

As per claim 74 and 76, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 38.

As per claim 78-79, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 51.

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Response to Arguments

7. Applicant's arguments with respect to claim 30-67 have been considered but are not persuasive in view of the new ground(s) of rejection.

As per Applicant's arguments concerning "Bernard., '213, fails to provide for the user management of prestored or modified play lists, including the creation or editing . . .", have been fully considered but are deemed moot in view of the new grounds of rejection.

As per Applicant's argument concerning "the intervening text associated with the first of the four phrases has been omitted . . . the omitted intervening text identifies the location information as corresponding to where those items can be found in the warehouse . . .", have fully been considered but are deemed moot in view of the new grounds of rejection.

As per Applicant's argument concerning "the phrase 'available titles' does not relate to the displayed lists independent of the sources of the media entries . . .", have been fully considered but are deem moot in view of the new grounds of rejection.

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Conclusion

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-308-9051 (**formal** communications intended for entry),

Or:

(703)-308-5403 (**informal** communications labeled **PROPOSED** or **DRAFT**).

Hand-delivered responses should be brought to:


Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford Kindred, whose telephone number is (703)-305-3802 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Razavi, can be reached at (703)-305-4713.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-3900.

AWK


JOSEPH H. FEILD
PRIMARY EXAMINER